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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/473,055 12/28/99 TADOKORO

T 425-754P

EXAMINER

IM22/0323

BIRCH STEWART KOLASCH & BIRCH LLP
P O BOX 747
FALLS CHURCH VA 22040-0747

CHIN.P

ART UNIT

PAPER NUMBER

1731

DATE MAILED:

03/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action SummaryApplication No.
09/473,055Applicant(s)
Tadokoro et alExaminer
Peter ChinGroup Art Unit
1731

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-13 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-13 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☒ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: 11-293150 and 11-301254

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The disclosure is objected to because of the following informalities: Page 15, imidazol (it is believed that imidazole is meant) is not represented by formulas b) thorough j), these compounds are not imidazoles; page 16, formulas (e), (g) and (h) contain errors. Formulas (e) and (h): group "OCOR" does not appear to be correct, it is believed that COOR is meant.

Formula (g): N.HOOCR is not correct, it is not clear what is meant. Applicant must review the specification and correct all deficiencies in the lengthy specification. New matter must be avoided

2. Claims 1-13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hutcheson (5,393,334 or 5,417,753), or Padbury et al (2,772,967) .

Hutcheson or Padbury et al show the addition of the claimed amide, formula b) and e) respectively, to paper. In as much as it is same amide as disclosed on pages 16 and 17, it is reasonable to expect that these prior art amides inherently have the claimed lyotropic degree and also the improvements in opacity, brightness and bulk. In any case improved brightness, opacity, brightness and sizing are taught by Hutcheson. Thus, Hutcheson or Padbury anticipates the claimed invention or at the least, obviously shows the claimed invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The term "efficiencies" is not an art recognized term; it appears that the term property or paper property is meant. Claim 1: This claim should be rewritten in proper method claim format under US practice; the phrase, "subjecting the resultant" to paper making is not understood. The preambles of claims 3-6 should be amended to state that it is a method. Claims 7 and 9, the term "anytime" is indefinite.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Chin whose telephone number is (703) 308-2046. The examiner can normally be reached from Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on (703) 308-3837. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

A handwritten signature in dark ink, appearing to read "Peter Chin", with a long, sweeping horizontal line extending to the right.

PETER CHIN
PRIMARY EXAMINER